

REMARKS

Claims 1-19 are pending in this application. Claims 1-16 and 19 stand rejected and claims 17 and 18 are objected to. By this Amendment, claims 1, 2, 9, 11, 12, 16, and 17 have been amended and added new claim 20. Applicant gratefully acknowledges the indication of allowable subject matter in claims 17 and 18. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Applicant notes that the Examiner has not acknowledged receipt of the priority documents filed with this application. Applicant requests acknowledgment of receipt of the priority document. Further, Applicant notes that the IDS filed along with the filing of this application has not been initialed and returned by the Examiner. For the Examiner's convenience, a copy of Applicant's art citation is included herewith. Applicant respectfully requests that the Examiner consider and initial the references.

Paragraph 2 of the Office Action objects to the Abstract. Applicant has amended the Abstract in light of the objections. Withdrawal of the objections is requested.

Paragraph 4 of the Office Action rejects claim 19 under 35 U.S.C. § 112, second paragraph. Applicant has amended claim 19. Therefore, Applicant respectfully requests withdrawal of this rejection.

Paragraphs 5 and 6 of the Office Action raise various informalities in claims 1, 2, 16, and 18. Applicant has amended claims 1, 2, 16, and 18 in light of the objections. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 1-2 and 5-8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,269,260 (“Shin”). Applicant respectfully traverses this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

Among the limitations of independent claim 1 not present in the cited reference is that “when the registered key word is extracted from the received

character data displayed on its display screen of the portable communication terminal apparatus, calling and executing the function registered in the portable communication terminal apparatus is in association with the extracted key word.”

In Shin, a user enters a specific character string using a touch screen. This character string is then associated with a specific function. Subsequently, when the user enters the character string via the touch screen, a CPU in the device will call the specific function. Simply put, Shin merely discloses a character recognition feature of a touch screen.

In contrast, according to Applicant’s explicitly recited claim, a function is associated with a word. When the word is received and extracted, the function is called. In other words, when a registered key word contained in the key word table is extracted from the received email message, the terminal performs a predetermined action associated with the action in the key word table, i.e., play a melody, sound effect function, blinking, and the like. This is different from the user entering the key word. Therefore, Shin does not disclose this explicitly recited feature and Applicant respectfully requests allowance of claim 1.

Claims 2-8 and 20 depend either directly or indirectly from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Shin and are also believed to be directed towards the patentable subject matter. Thus, claims 2-8 and 20 should also be allowed.

Claims 9-12 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shin in view of U.S. Patent No. 6,445,932 (“Soini”). Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

As discussed above, Shin fails to disclose “means for extracting the key word from received character data displayed on said displaying section ... and means for calling the function associated with the extracted key word.” Soini was not included to cure this deficiency but to disclose a “display section for displaying graphic pattern.” Office Action at 8. However, Soini fails to cure the deficiency in Shin discussed above. Additionally, the Hoshiro and Jahagirdon reform also fails to cure the above deficiency. Therefore, Applicant respectfully submits that claim 9 is also allowable over the cited combination.

Claims 10-16 and 19 depend from, and contain all the limitations of claim 9. These dependent claims also recite additional limitations which, in combination

with the limitations of claim 9, are neither disclosed nor suggested by Soini and are also believed to be directed towards the patentable subject matter. Thus, claims 10-19 should also be allowed.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

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Attachment – (copy of PTO-1449, filed 5/8/2001)